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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,972	06/30/2006	Antoni Picornell Garau	02136/0205064-US0	3405

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EXAMINER	
GULLEDGE, BRIAN M	

ART UNIT	PAPER NUMBER
1619	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/596,972	PICORNELL GARAU, ANTONI	
	Examiner	Art Unit	
	Brian Gulledge	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/30/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112, 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 contains the trademark/trade name Tween 80. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the surfactant present in the composition and, accordingly, the identification/description is indefinite.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the phrase "preferably," which renders the claim

indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites replacement materials for Tween 80, including "(polysorbate 80)" and "(sorbitan polyester)." It is unclear what the claim is reciting. First, both limitations are presented in parentheses, but there is no term immediately before each set of parentheses. Further, polysorbate 80 is an alternate name for Tween 80, so it is not clear in what manner this term is different than Tween 80.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vroman (PCT Patent Application Publication WO 01/85112) in view of Naimark (US Patent 2,833,693). Vroman discloses shaving cream formulations comprising emulsifying agents (such as polysorbate-80), skin conditioning agents (such as triethanolamine), hydrotopes (such as glycerin and urea), and viscosity enhancing agents (page 4, line 24 – page 5, line 7 and page 6, table 1). Vroman teaches the emulsifying agent is present in from 1 to 15 wt% (page 5, lines 18-

19), the skin conditioning agent is present in from 1 to 5 wt% (page 5, lines 8-10), and hydrotopes are present in from 1 to 10 wt% (page 5, lines 30-31), amounts that overlap the instantly recited amounts. And in cases involving overlapping ranges, the courts have consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness. *In re Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Thus, Vroman teaches all of the instantly recited ingredients and amounts except for the inclusion of sodium carboxymethylcellulose.

Naimark discloses transparent shaving cream (title), and teaches the inclusion of from 1.5 to 2.5 wt% of sodium carboxymethylcellulose to provide the desired viscosity to the composition (column 2, lines 26-30).

Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have used sodium carboxymethylcellulose as the viscosity enhancing agent in the composition disclosed by Vroman. Generally, it is *prima facie* obvious to select a known material (sodium carboxymethylcellulose) for incorporation into a composition, based on its recognized suitability for its intended use. See MPEP 2144.07. With regards to the limitation that the composition is transparent, as similar ingredients to the instantly recited ingredients are taught in a transparent gel by Naimark, and the taught ingredients are the same species present in an amount similar to the amounts instantly recited, it appears reasonable to believe that the product is transparent. Finally, instant claims 3-6 recite that it would be possible to substitute various other recited ingredients, and neither Vroman nor Naimark teach that these ingredients cannot be used in the disclosed invention.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amidon et al. (US Patent 5,455,286) in view of Woodin et al. (US Patent 5,494,533). Amidon et al. discloses a viscous gel composition for delivering bioactive agents (column 2, lines 46-53). The gel can comprise neutralizing agents such as triethanolamine (column 5, lines 26-31) in from 0.3 to 10 wt% (column 5, lines 43-46). The solvent system also comprises an emulsifying agent such as Tween 80 (column 6, lines 53-58), present in about 1.5 wt% (column 8, example 1). These amounts overlap the instantly recited amounts, and in cases involving overlapping ranges, the courts have consistently held that even a slight overlap in range establishes a *prima facie* case of obviousness. *In re Peterson*, 65 USPQ2d 1379, 1382 (Fed. Cir. 2003). Amidon et al. also discloses the inclusion of a hydrophilic polymer (column 4, lines 52-66), that sodium carboxymethylcellulose can be used, and that the amount of the sodium carboxymethylcellulose can be varied depending on the desired viscosity of the composition (column 3, lines 16-23 and figures 6-7). The instantly recited amounts of sodium carboxymethylcellulose would be *prima facie* obvious, as a skilled artisan could optimize the amount to achieve the desired viscosity by varying the amount of the sodium carboxymethylcellulose. Amidon et al. does not teach the inclusion of glycerin or urea in the composition.

Woodin et al. discloses compositions for application to the skin (column 1, lines 9-11). Woodin et al. further teaches that these compositions can comprise a moisturizer such as glycerin, urea, or mixtures thereof in from 1 to 20 wt% (column 7, line 54 – column 8, line 3).

Therefore, it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the moisturizers glycerin and urea into the composition disclosed by Amidon et al. The inclusion of these agents would moisten and

improve the skin of the user, a desirable effect. And with regards to the limitation that the composition is transparent, since the same ingredients are taught in a gel and are present in amounts similar to the amounts instantly recited, it appears reasonable to believe that the product is transparent. Finally, instant claims 3-6 recite that it would be possible to substitute various other recited ingredients, and neither Amidon et al. nor Woodin et al. teach that these ingredients cannot be used in the disclosed invention.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gulledge whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612